

SERIAL NO. 10/707,618

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Aaron J. Golle et al. Examiner: Jason M. Han

Serial No.: 10/707,618 Group Art Unit: 2875

Filed: December 24, 2003 Docket: 1748.005US1

For: MULTI-COLORED EL SAFETY SIGN

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APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on May 29, 2007, from the Final Rejection of claims 1, 3, 4, 10-12, 15 and 16 of the above-identified application, as set forth in the Final Office Action mailed on March 12, 2007.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$255.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

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**1. REAL PARTY IN INTEREST**

The real party in interest of the above-captioned patent application is the assignee, SAFE LITES, LLC.

**2. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

**3. STATUS OF THE CLAIMS**

The present application was filed on December 24, 2003 with claims 1-20. A non-final Office Action was mailed September 14, 2005. In a response filed February 16, 2006, claims 2, 5-9, 13-14 and 17-20 were cancelled. A Final Office Action was mailed February 28, 2007. Claims 1, 3, 4, 10-12, 15 and 16 stand finally rejected, remain pending, and are the subject of the present Appeal.

**4. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Final Office Action dated February 28, 2007.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

Aspects of the present inventive subject matter include, but are not limited to, a multi-colored electroluminescent safety sign.

### **INDEPENDENT CLAIM 1**

Claim 1 includes an electroluminescent (“EL”) sign [*page 5, paragraph 28*] for use on a vehicle [*page 5, paragraph 30*] comprising an EL illuminated color and a non-illuminated color, and further including an EL lighting element that is white in a non-illuminated condition and blue-green in an illuminated condition, and a yellow layer that imparts a yellow tint to the sign in daylight when the EL lighting element is non-illuminated and a light green appearance at night when the EL lighting element is illuminated [*page 7, paragraph 34*].

### **DEPENDENT CLAIM 3**

An aspect of the subject matter recited in independent claim 1 is included in which the non-illuminated color is effective for signaling a safety message in daylight [*page 9, paragraph 36*].

### **DEPENDENT CLAIM 4**

An aspect of the subject matter recited in independent claim 1 is included in which the illuminated color is effective for signaling a safety message in the dark or other conditions of poor visibility [*page 7, paragraph 34*].

### **DEPENDENT CLAIM 10**

An aspect of the subject matter recited in independent claim 1 is included in which the EL sign includes safety indicia defined by the illuminated color [*page 7, paragraph 34*].

#### **DEPENDENT CLAIM 11**

An aspect of the subject matter recited in independent claim 1 is included in which the EL sign includes safety indicia defined by the non-illuminated color *[page 7, paragraph 34]*.

#### **DEPENDENT CLAIM 12**

An aspect of the subject matter recited in independent claim 1 is included in which the EL sign includes safety indicia defined by the illuminated color and the non-illuminated color *[page 7, paragraph 34]*.

#### **DEPENDENT CLAIM 15**

The EL sign of claim 1, wherein the EL lighting is static *[page 10, paragraph 39]*.

#### **DEPENDENT CLAIM 16**

The EL sign of claim 1, wherein the EL lighting is blinking *[page 10, paragraph 39]*.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the invention.

**6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1, 3-4, 10-12 and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman (U.S. Patent No. 5,553,289) (hereinafter “Hoffman”).

## 7. ARGUMENT

### *A) The Applicable Law*

#### *Under 35 U.S.C. §103 – Obviousness*

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)). “Mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.” *In re Kahn*, 2006 WL 708687, \*9 (Fed. Cir. 2006).

Such a teaching or suggestion must be supported by substantial evidence. *Id* at \*8. Substantial evidence is something more than a mere scintilla of evidence. *Id*. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) (quoting *In re Kahn* at \*10). “When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co. v. Teleflex Inc.* at \*11.

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***B) Claims 1, 3-4, 10-12 and 15-16 were improperly rejected under 35 USC § 103 as being unpatentable over Hoffman.***

## **CLAIM 1 AND ITS DEPENDENT CLAIMS**

**Hoffman fails to teach all the elements of the claimed subject matter.**

The Applicants' claim 1 sets forth:

1. An EL sign for use on a vehicle comprising an EL illuminated color and a non-illuminated color, and further including an EL lighting element that is white in a non-illuminated condition and blue-green in an illuminated condition, and a yellow layer that imparts a yellow tint to the sign in daylight when the EL lighting element is non-illuminated and a light green appearance at night when the EL lighting element is illuminated.

This is a novel and inventive manner to provide a highly useful EL sign for a vehicle. In particular, the Applicants' claimed invention provides a combination of EL lighting elements that impart a yellow tint to the sign in daylight when the EL element is non-illuminated, and a light green appearance at night when the EL element is illuminated. This allows the EL sign to, among other things, be highly visible during the day, and in addition, meet government regulations for a sign coloring at night where a light green appearance is required. To achieve this functionality, the claimed combination requires an EL lighting element that is white in a non-illuminated condition, and blue-green in an illuminated condition, together with a yellow layer.

Claim 1, however, is alleged to be obvious in view of Hoffman. Applicant respectfully asserts that this is in error because Hoffman does not teach all the elements of the Applicants' invention as set forth in claim 1, and because Hoffman actually teaches away from the claimed subject matter. In particular, Hoffman teaches an illuminated sign that includes an illuminated portion visible through an indicia defining member (e.g., a stencil). See, Background of Hoffman. Hoffman is silent as to the design or function of a sign which has a first desired color during the daylight in a non-illuminated condition, and a second, different color for use in the evening in an illuminated condition. Additionally, Hoffman is silent as to the particular color combination claimed by the Applicants wherein the sign has a yellow tint during the day and a

light green appearance at night. In fact, the Office Action dated February 28, 2007 admits that Hoffman “does not specifically teach a yellow color in the day with a white EL color in non-illuminated condition with a yellow layer and obtaining a green illuminated color at night by using a white EL color that illuminates as a blue-green color to provide the green color at night”. See, Paragraph 2 of the Office Action dated February 28, 2007.

The Examiner has cited no prior art, nor taken any official notice of prior art, addressing the elements of Applicants’ claimed invention that are missing from Hoffman. Far from being obvious to modify Hoffman without any guidance from the prior art, Hoffman itself suggests no modifications that would lead to Applicants’ invention. More particularly, Hoffman does not suggest a sign that would have two different colors depending on its state of illumination, nor based on the time of day and ambient lighting conditions. If Hoffman teaches anything, which is not admitted in any event, Hoffman may teach that a transparent layer could be applied to the EL lighting surface to enhance the EL light color in a steady illuminated conditions, but certainly not to allow for different color appearance of the sign depending on whether it’s day or night, or illuminated or non-illuminated.

Hoffman’s teaching, on the other hand, is focused on the use of stencils to provide indicia on a sign at a low cost. Accordingly, it teaches away from the Applicant’s invention, which has nothing to do with stenciling.

Accordingly, the rejection fails to state a *prima facie* case of obviousness against the Applicants’ claim 1, and the claims depending therefrom. For at least these reasons, claim 1 is believed to be patentable over Hoffman. Claims 3-4, 10-12 and 15-16 all ultimately depend on claim 1 and are believed to be allowable at least for the reasons provided with respect to that claim.

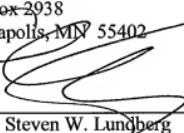
## 8. SUMMARY

For the reasons argued above, claims 1, 3-4, 10-12 and 15-16 were improperly rejected under 35 USC § 103(b) as being anticipated by Hoffman. It is respectfully submitted that the art cited does not render the claim obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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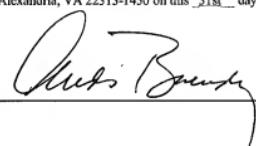
  
Steven W. Lundberg  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of December 2007.

CANDIS BUENDING

Name

Signature



**CLAIMS APPENDIX**

1. An EL sign for use on a vehicle comprising an EL illuminated color and a non-illuminated color, and further including an EL lighting element that is white in a non-illuminated condition and blue-green in an illuminated condition, and a yellow layer that imparts a yellow tint to the sign in daylight when the EL lighting element is non-illuminated and a light green appearance at night when the EL lighting element is illuminated.
3. The EL sign of claim 1 wherein the non-illuminated color is effective for signaling a safety message in daylight.
4. The EL sign of claim 1 wherein the illuminated color is effective for signaling a safety message in the dark or other conditions of poor visibility.
10. The EL sign of claim 1, further comprising safety indicia defined by the illuminated color.
11. The EL sign of claim 1, further comprising safety indicia defined by the non-illuminated color.
12. The EL sign of claim 1, further comprising safety indicia defined by the illuminated color and the non-illuminated color.
15. The EL sign of claim 1, wherein the EL lighting is static.
16. The EL sign of claim 1, wherein the EL lighting is blinking.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.